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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/027, 777 02/23/98 IMMER

H P108099-0000

EXAMINER

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HM12/0607

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ART UNIT	PAPER NUMBER
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1644

DATE MAILED:

06/07/01

**Please find below and/or attached an Office communication concerning this application or proceeding.****Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>09/027,777</b>	Applicant(s) <b>Immer et al</b>
	Examiner <b>E. Pierre VanderVegt</b>	Art Unit <b>1644</b>



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1)  Responsive to communication(s) filed on May 22, 2001
- 2a)  This action is FINAL.      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

#### Disposition of Claims

- 4)  Claim(s) 21-34 is/are pending in the application.
- 4a) Of the above, claim(s) 21-27 and 34 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 28-33 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11)  The proposed drawing correction filed on \_\_\_\_\_ is: a)  approved b)  disapproved.
- 12)  The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

- 13)  Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a)  All b)  Some\* c)  None of:

1.  Certified copies of the priority documents have been received.
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\*See the attached detailed Office action for a list of the certified copies not received.

- 14)  Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

- 15)  Notice of References Cited (PTO-892)      18)  Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16)  Notice of Draftsperson's Patent Drawing Review (PTO-948)      19)  Notice of Informal Patent Application (PTO-152)
- 17)  Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_      20)  Other: \_\_\_\_\_

## **DETAILED ACTION**

This application is a divisional of application S.N. 08/737,927 which is a rule 371 continuation of PCT/EP95/02050.

New claim 34 has been added.

5           Claims 21-34 are currently pending in this application.

### ***Continued Prosecution Application***

1.       The request filed on May 22, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/027,777 is acceptable and a CPA has 10 been established. An action on the CPA follows.

### ***Election/Restriction***

2.       A restriction was required under 35 USC § 121 in the parent application, Paper No. 16 between (one of the following groups):

- 15           I.       Claims 21-27, drawn to a method of purifying cardiodilatin fragments by elution from HPLC.
- II.       Claims 28-33, drawn to cardiodilatin fragments.

20           Applicant elected Group II, claims 28-33 **without** traverse in Paper No. 18. This restriction requirement is hereby reiterated. New claim 34, filed February 26, 2001, is also drawn to the method of Group I. Accordingly, claims 21-27 and 34 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being 25 no allowable generic or linking claim.

3.       In view of the amendment filed February 26, 2001, and the request for CPA filed without responsive remarks on May 22, 2001, the following rejections are maintained without further comment.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless --

5 (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the Applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(f) he did not himself invent the subject matter sought to be patented.

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4. Claims 28-33 stand rejected under 35 U.S.C. 102(b) as being clearly anticipated by U.S. Patent No. 4,751,284 to Forssmann (A on form PTO-892).

The '284 patent teaches cardiodilatin and fragments thereof. Specifically, claim 1 of the '284 patent is drawn to full length cardiodilatin and claim 2 is drawn to biologically active fragments thereof. More specifically, claim 28 of the '284 patent is drawn to a cardiodilatin fragment which is the same as the ANP(99-126) peptide instantly disclosed and specifically claimed [instant claim 31]. Therefore, claim 28 of the '284 patent specifically teaches the cardiodilatin fragments of the instantly claimed invention where R<sup>1</sup> is 99-104 [instant claim 29], R<sup>2</sup> is 122-126 [30] which are fragments of 90-104 and 122-126 [28], respectively, wherein said fragments are attached to a core which is the same as SEQ ID NO:1. Applicant is reminded that the recitation of "having" in claim 33 is considered open terminology and therefore includes longer amino acid sequences which "have" the recited sequence contained therein. The prior art teaching clearly anticipates the claimed invention.

25 5. Claims 28-33 stand rejected under 35 U.S.C. 102(a) as being clearly anticipated by U.S. Patent No. 5,449,751 to Forssmann et al (AA on form PTO-1449).

The '751 patent teaches the cardiodilatin fragment R<sup>1</sup>-ANP(105-121)-R<sup>2</sup> wherein R<sup>1</sup> is ANP(95-104) [instant claim 29] and R<sup>2</sup> is ANP(122-126) (Abstract and claim 1 of the '751 patent in particular). The '751 patent additionally teaches the fragments of amino acids 99-126

(column 1, line 6 in particular) and 95-125 (column 9, line 36 in particular) as well as pharmaceutical compositions (medicaments; column 3, lines 37-61 in particular). Applicant is reminded that the recitation of "having" in claim 33 is considered open terminology and therefore includes longer amino acid sequences which "have" the recited sequence contained therein. The prior art teaching clearly anticipates the claimed invention.

6. Claims 28-33 stand rejected under 35 U.S.C. 102(f) because the Applicant did not invent the claimed subject matter.

U.S. Patent No. 4,751,284 (A) has been discussed supra. The '284 patent discloses that the instantly claimed subject matter was invented in its entirety by Wolf-Georg Forssmann (see entire document). Therefore, Hansueli Immer, Knut Adermann and Christian Klessen are not inventors of the instantly claimed invention.

### *Conclusion*

7. This is a CPA of Applicant's earlier Application No. 09/027,777. All claims are drawn to the same invention claimed in the earlier application and could have been finally rejected on the grounds and art of record in the next Office Action if they had been entered in the earlier application. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Papers related to this application may be submitted to Technology Center 1600, Group 1640 by facsimile transmission. Papers should be faxed to Group 1640 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The fax phone number for official documents to be entered into the record for Art Unit 1644 is (703)305-3014.

5 Any inquiry concerning this communication or earlier communications from the Examiner should be directed to F. Pierre VanderVegt, whose telephone number is (703)305-6997. The Examiner can normally be reached Tuesday through Friday and odd-numbered Mondays (on year 2000 366-day calendar) from 6:30 am to 4:00 pm ET. A message may be left on the 10 Examiner's voice mail service. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ms. Christina Chan can be reached at (703)308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist, whose telephone number is (703)308-0196.

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F. Pierre VanderVegt, Ph.D.

Patent Examiner

20 Technology Center 1600

June 6, 2001